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EXAMINER

WINTERS, MAREISHA N

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/605,544

Applicant(s)

COLE ET AL.

Examiner

Mareisha N. Winters

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. This office action is in response to the communication filed on July 25, 2003. Claims 1-10 and 12-22 remain pending in the application.

2. In view of the paper filed on July 25, 2003, PROSECUTION IS HEREBY REOPENED.

A new ground of rejection is set forth below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 6-10, 16, 17, 19, 20 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,122,372 to Hughes (hereinafter "Hughes").

In considering claim 1, Hughes discloses a method for exchanging data between a source location and a destination location (column 5, lines 39-41) comprising:

generating a data file with a markup language in accordance with a predetermined schema (column 8, lines 35-39);

generating a first software envelope containing the data file (column 6, lines 6-14);

transmitting the data file software envelope to the destination location (column 5, lines 64-67 – column 6, lines 1-5); and

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creating an object from the data file with a plug-in object corresponding to the predetermined schema (column 9, lines 25-32).

In considering claim 6, 19, and 22, Hughes further discloses wherein the markup language comprises standard generalized markup language (SGML) (column 8, lines 35-39).

In considering claim 7, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via electronic mail (column 8, lines 43-44).

In considering claim 8, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via HTTP (column 8, lines 43-45; Note that it is inherent that HTML is sent via HTTP).

In considering claim 9, Hughes further discloses wherein the step of transmitting comprises transmitting the software envelope via an intermediate server (column 5, lines 48-52).

In considering claim 10, Hughes further discloses a computer-readable medium having computer-executable instructions for performing the steps recited in claim 1 (Note that it is inherent that in order to perform the method steps there must be a computer-readable medium with computer-executable instructions.).

In considering claim 16, Hughes discloses a method for creating data at a source location to transmit to a destination location (column 5, lines 39-41), comprising the steps of:

generating a data file with a markup language in accordance with a predetermined schema (column 8, lines 35-39);

generating a software envelope containing the data file (column 6, lines 6-14);

identifying a plug-in object that creates an object from the data file (column 9, lines 25-32); and

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transmitting the software envelope to the destination location (column 5, lines 64-67 – column 6, lines 1-5).

In considering claim 17, Hughes further discloses wherein generating a software envelope containing the data file (column 6, lines 6-14) and the plug-in object (column 9, lines 25-32).

In considering claim 20, Hughes discloses a method for extracting data from a file transmitted from a source location, comprising the steps of:

receiving a software envelope containing a data file marked up with a markup language in accordance with a predetermined schema (column 5, lines 64-67 – column 6, lines 1-5); and

creating an object from the data file with a plug-in object corresponding to the predetermined schema (column 9, lines 25-32).

5. Claims 12-15 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,446,110 to Lektion et al. (hereinafter “Lektion”).

In considering claim 12, Lektion discloses a computer-readable medium having stored thereon a data structure comprising:

a data field containing address information (see column 9, line 19 (“host port number”));

a data field containing the identification of a predetermined schema (see column 9, lines 4-6);

a data field containing a data file formatted with a markup language in accordance with the schema (see column 9, lines 7-9); and

a data field containing manifest information corresponding to the information contained in the data file data field (see column 9, lines 7-9 and 22-30).

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In considering claim 13, Lektion et al. further discloses a data field containing state information (see column 9, lines 16-18).

In considering claim 14, Lektion et al. further discloses wherein the state information contains address information (see column 9, line 19 (“host port number”)).

In considering claim 15, Lektion et al. further discloses wherein the address information contains an address for replying to a message (see Fig. 4; Note that the double arrows show that the datastreams are going in both directions between the source and destination and therefore the address information must contain an address for replying to the datastream message in order for it to be transmitted back to the host.).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes in view of Lektion.

In considering claims 5, 18 and 21 Hughes fails to disclose *wherein the markup language comprises extensible markup language (XML)*. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes, as evidenced by Lektion. Lektion discloses that the markup language of the data file comprises extensible markup language (column 6, lines 34-35). A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system disclosed

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by Hughes by incorporating this well known feature, such as disclosed by Lection, in order to allow for greater flexibility in organizing and presenting information in the data file.

8. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes in view of U.S. Patent No. 6,507,856 to Chen et al (hereinafter "Chen").

In considering claim 2, Hughes fails to disclose *automatically generating a second software envelope from the information contained in the first software envelope*. Nonetheless, this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes, as evidenced by Chen. In an analogous art Chen discloses a system for exchanging messages over a network including automatically generating a second software envelope from the information contained in the first software envelope (column 3, lines 50-60). A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system disclosed by Hughes by incorporating this well known feature, such as disclosed by Chen, in order to allow for greater efficiency when transferring a document back to the original destination.

In considering claim 3, Hughes further discloses wherein the first software envelope contains destination and source address information (Fig. 2, "210" and "214") however it fails to disclose *generating a second envelope having a destination address matching the source address of the first envelope*. Nonetheless, this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes, as evidenced by Chen. In an analogous art Chen discloses a system for exchanging messages over a network including generating a second envelope having a destination address matching the source address of the first envelope (column 3, lines 50-60). A person having ordinary skill in the art would have readily recognized

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the desirability and advantages of modifying the system disclosed by Hughes by incorporating this well known feature, such as disclosed by Chen for the reasons cited above with respect to claim 2.

In considering claim 4, Hughes further discloses wherein the first software envelope contains state information (Fig. 2) however it fails to disclose *generating a second envelope having a destination address determined by the state information*. Nonetheless, this feature is well known in the art and would have been an obvious modification to the system disclosed by Hughes, as evidenced by Chen. In an analogous art Chen discloses a system for exchanging messages over a network including generating a second software envelope having a destination address determined by the state information (column 3, lines 50-60). A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system disclosed by Hughes by incorporating this well known feature, such as disclosed by Chen, for the reasons cited above with respect to claim 2.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 16 and 20 (and their respective dependent claims) have been considered but are moot in view of the new ground(s) of rejection.

10. In considering Applicant's arguments regarding claim 12 that Lektion fails to teach the feature of "a data field containing manifest information corresponding to the information contained in the data file data field," the Office respectfully disagrees. According to the Applicant's definition of "manifest information" Lektion discloses this feature. Applicant's attention is drawn to column 9, lines 22-30. Lektion teaches that the datastreams authored according to a DTD contain contents and attributes for the data (host screen image), in which the

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content describes the detailed information about the host screen fields including text content and text attributes. This is considered to be a description of the document (host screen image), which is how the manifest information is defined according to the applicant (see page 13 of the amendment lines 3-5). Therefore, Lektion teaches the limitations of claim 12.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: U.S. Patent No. 6,151,602 to Hejlsberg et al. and U.S. Patent No. 6,560,607 to Lassenen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mareisha N. Winters whose telephone number is (703) 305-7838. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for official communications, (703) 746-7240 for non-official communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Mareisha N. Winters
Patent Examiner
Art Unit 2153
August 5, 2003


KRISNA LIM
PRIMARY EXAMINER